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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,753	03/04/2004	Tsutomu Fujimura	249976US0	5264

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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LEITH, PATRICIA A

ART UNIT	PAPER NUMBER
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1655

NOTIFICATION DATE	DELIVERY MODE
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10/09/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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## Office Action Summary

Application No.

10/791,753

Applicant(s)

FUJIMURA, TSUTOMU

Examiner

Patricia Leith

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/10/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5, 8, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 9, 10, 12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-6 and 8-17 are pending in the application.

Applicant has cancelled the species previously searched on the merits; i.e., *Ziziphus jujuba* extract. Therefore, the Examiner has chosen another species for examination on the merits; extract of *Petroselinium sativum*, also known as 'parsley'

### ***Election/Restrictions***

This application contains claims 1-3 and 5 drawn to an invention nonelected with traverse in Paper No. 4/18/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Because claims 8, 11 and 13 are directed toward a non-elected invention (i.e., plant part or plant), these claims have been withdrawn from consideration on the merits.

Claims 4, 6 and 9-10, 12 and 14-17 were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 9, 10, 12, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Uda et al. (JP 2000344655 A).

Uda et al. (JP 2000344655 A) disclose:

To obtain a skin cosmetic having improved active oxygen scavenging activity, and capable of suppressing the oxidation of skin cells and exhibiting bleaching effect by compounding an extract obtained through extraction from a polyphenol-containing plant and an extract from parsley in combination.

SOLUTION: (A) One or more kinds of extracts obtained from a polyphenol-containing plant (e.g. fruits such as apple, grape or strawberry, or their seeds, or beans such as red beans or soybeans) or the like and (B) an extract obtained from parsley are formulated. The extraction can be carried out by using an extraction solvent such as water, a polyhydroxy alcohol like glycerin, or a lower alcohol like ethanol. Further, it is preferable that the formulation amount of the component A is 0.0001-5.0 wt.% and that of the component B is 0.001-5.0 wt.% based on the total weight of the skin cosmetic, and the formulation ratio of the component A to B is 0.01-100.0 in component A/component B.

Clearly, Uda et al. disclosed the use of 0.001 to 5% by weight of an extract (by weight of the cosmetic) of parsley (*Petroselinium sativum*) which falls completely within the claimed ranges of plant extract material. Since the extraction was from parsley, it is deemed that the extraction was done on the entire plant, which includes the leaves of the plant. It is deemed that claim 10 is anticipated because the cosmetic of Uda et al. is deemed to fall within the metes and bounds of 'foundation' in that the cosmetic is applied to the skin.

***Claim Rejections - 35 USC § 103***

Claims 4, 6 and 9-10, 12 and 14-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Uda et al. (JP 2000344655 A).

The teachings of Uda et al. were discussed *supra*. Uda et al. did not specifically teach the measurements of the area of the skin which was to be treated.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). see MPEP § 2144.05 part II A. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to determine all operable and optimal amounts of parsley extract to apply to the skin dependant on the surface area afflicted. Uda et al.

Art Unit: 1655

make clear that the cosmetic "... improved active oxygen scavenging activity, and capable of suppressing the oxidation of skin cells and exhibiting bleaching effect..." and thus, is considered an art-recognized result-effective variable which would have been routinely determined and optimized in the pharmaceutical art. Further, if there are any differences between Applicant's claimed method and that suggested by the combined teaching of the prior art, the differences would be appear minor in nature. Although the prior art does not specifically teach the measurements of the surface area to be treated, again, the ordinary artisan would have been motivated to vary the amount of product administered to the skin dependant on the amount of surface area in need of treatment in order to maximize efficacy of the cosmetic composition.

The Supreme court has acknowledged that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. **If a person of ordinary skill can implement a predictable variation..103 likely bars its patentability...**if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions...

**...the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results** (see *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 U.S. 2007) emphasis added.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of

Art Unit: 1655

ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No claims are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

Art Unit: 1655

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia Leith  
Primary Examiner  
Art Unit 1655

September 29, 2007

A handwritten signature in black ink, appearing to read 'Patricia Leith', with a large, stylized initial 'P' and a long, sweeping horizontal stroke extending to the right.